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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ORVALLE THEODORE KIRBY, GREGORY MICHAEL  
NORDSTROM GREGORY FRANCIS PFISTER,  
RENATO JOHN RECIO, and STEVEN MARK THURBER

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Appeal 2008-002920  
Application 09/692,365<sup>1</sup>  
Technology Center 2100

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Decided: <sup>2</sup> May 29, 2009

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Before JOSEPH L. DIXON, JAY P. LUCAS, and  
CAROLYN D. THOMAS, *Administrative Patent Judges*.

C. THOMAS, *Administrative Patent Judge*.

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<sup>1</sup> Application filed October 19, 2000. The real party in interest is International Business Machines Corporation.

<sup>2</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## DECISION ON APPEAL

### I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-27 mailed June 17, 2005, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

### A. INVENTION

Appellants invented a system, method, and computer readable medium for managing configuration information for a set of components in a network computing system. The configuration information is stored for the set of components in the network computing system to form stored configuration information. Current configuration is obtained in response to a power cycle. The current configuration information is compared with the stored configuration information to form a comparison. The stored configuration information is updated if a difference is present in the comparison. The stored configuration is used to configure the components when a power cycle occurs. (Spec. 44, Abstract.)

### B. ILLUSTRATIVE CLAIMS

The appeal contains claims 1-27. Claims 1, 8, 9, 11, 15, 22, and 25-27 are independent claims. Claims 1, 8, 9, and 11 are illustrative:

1. A method in a network computing system for managing configuration information for a set of components in a network computing system, the method comprising:

storing the configuration information for the set of components in the network computing system to form stored configuration information;

responsive to a power cycle, obtaining current configuration information from the set of components;

comparing the current configuration information with the stored configuration information to form a comparison;

updating the stored configuration information if a difference is present in the comparison.

8. A method in a network computing system for managing configuration information in the network computing system, the method comprising:

discovering a component at a location on the network computing system;

determining whether the component was previously in the location;

configuring the component using previously stored configuration information for the component if the component was previously in the location; and

configuring the component without the previously stored configuration information if the component was not previously in the location.

9. A method in a network computing system for managing configuration information [sic] the network computing system, the method comprising:

discovering a component at a location on the network computing system;

determining whether stored configuration information is present at the component;

responsive to the stored configuration information being present at the component, reading the stored configuration information;

configuring the stored configuration information;

determining whether changes to a configuration of the component are present; and

responsive to changes being present, updating the changes to the stored configuration information in the component.

11. A data processing system comprising:  
a bus system;  
a communications adapter connected to the bus system;  
a memory including a set of instructions connected to the bus system;

a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to store the configuration information for the set of components in the network computing system to form stored configuration information; obtain current configuration information from the set of components responsive to a power cycle; compare the current configuration information with the stored configuration information to form a comparison; and update the stored configuration information if a difference is present in the comparison.

### C. REFERENCES

The references relied upon by the Examiner as evidence in rejecting the claims on appeal are as follows:

Pelissier	US 6,496,503 B1	Dec. 17, 2002 (Filed Jun. 1, 1999)
Shah	US 6,694,361 B1	Feb. 17, 2004 (Filed Jun. 30, 2000)

#### D. REJECTIONS

The Examiner entered the following rejections which are before us for review:

(1) Claims 1-10 and 15-27 are rejected under 35 U.S.C. § 102(e) as being anticipated by Pelissier; and

(2) Claims 11-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shah in view of Pelissier.

#### II. PROSECUTION HISTORY

Appellants appealed from the Final Rejection and filed a Supplemental Appeal Brief (App. Br.) on November 21, 2006. The Examiner mailed a revised Examiner's Answer (Ans.) on June 14, 2007. Appellants filed a Reply Brief (Reply Br.) on August 14, 2007.

#### III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

##### *Pelissier*

1. Pelissier discloses that "each device is not responsible for learning the topology of the network or generating their own forwarding databases. Rather, a central network manager is responsible for discovering the topology of the network . . . and then initializing each device by providing the assigned address and the forwarding database to each device for storage." (Col. 2, ll. 48-55.)

2. In Pelissier, “a technique must be provided that allows the central network manager to route management cells throughout a network or fabric whose configuration is unknown.” (Col. 2, ll. 58-61.)

3. Pelissier “allows the central network manager to route management cells to specific devices in an unconfigured or partially configured network using explicit routing to initialize or configure each device.” (Col. 2, l. 66 to col. 3, l. 2.)

4. In Pelissier, “the devices in the network power-up without individual addresses assigned to them and without a forwarding database” (col. 2, ll. 44-46).

5. Pelissier discloses:

In addition, the network topology can change when devices or communication links are added, removed or relocated, when communication links or devices fail, etc. As such, the central network manager 150 may periodically rediscover the network topology, reassign MAC addresses to devices, and generate updated forwarding databases for each device based on the new network topology.

(Col. 13, ll. 6-12.)

6. Pelissier discloses that “[t]he central network manager 150 can read (or query) a device’s address by specifying the Get( ) command and the MAC\_address COD in a management cell, or can update or initialize a device’s MAC address by specifying the Set( ) command” (col. 9, l. 34-38).

#### IV. PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis*

*Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 US 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Brief to show error in the proffered *prima facie* case. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief has not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii).



## V. ANALYSIS

### *Grouping of Claims*

In the Supplemental Appeal Brief:

Group I: Appellants argue claims 1-7, 15-21, and 25 as a group (App. Br. 12-15). For claims 2-7, 15-21, and 25, Appellants repeat the same argument made for claim 1. We will, therefore, treat claims 2-7, 15-21, and 25 as standing or falling with claim 1.

Group II: Appellants argue claims 8, 22, and 26 as a group (App. Br. 16-17). For claims 22 and 26, Appellants repeat the same argument made for claim 8. We will, therefore, treat claims 22 and 26 as standing or falling with claim 8.

Group III: Appellants argue claims 9, 10, 23, 24, and 27 as a group (App. Br. 17). For claims 10, 23, 24, and 27, Appellants repeat the same argument made for claim 9. We will, therefore, treat claims 10, 23, 24, and 27 as standing or falling with claim 9.

Group IV: Appellants argue claims 11-14 as a group (App. Br. 18-19). For claims 12-14, Appellants repeat the same argument made for claim 11. We will, therefore, treat claims 12-14 as standing or falling with claim 11.

*See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

### *The Anticipation Rejection*

We first consider the Examiner's rejection of the claims under 35 U.S.C. § 102(e) as being anticipated by Pelissier.

*Group I*  
*Claims 1-7, 15-21, and 25*

Appellants contend that “Pelissier does not teach that the device is queried to obtain the device information when the device is powered-up.” (App. Br. 14.) Appellants further contend that “[m]erely being able to query or update data objects does not teach obtaining current configuration information responsive to a power cycle.” (*Id.*)

The Examiner found that “the central network manager 150 is responsible for discovering the topology of the network . . .” (Ans. 19).

Issue: Have Appellants shown that the Examiner erred in finding that Pelissier discloses *responsive to a power cycle, obtaining current configuration information from the set of components*?

While we agree with the Examiner that Pelissier discloses a central network manager that is responsible for discovering the topology of the unconfigured or partially configured network (FF 1-3), the Examiner has not established and we do not readily find where Pelissier discloses that such topology discovery is done responsive to a power cycle. Claim 1 recites, *inter alia*, “responsive to a power cycle, obtaining current configuration information from the set of components.” Pelissier merely states that the devices in the network power-up without individual addresses assigned to them and without a forwarding database (FF 4). While the Examiner has illustrated various topology techniques in Pelissier (Ans. 12-19), the Examiner has not identified any “power-cycle” directives in Pelissier, particularly obtaining current configuration information responsive to a power cycle. Further, the Examiner has not shown where Pelissier discloses

comparing the current configuration information (obtained responsive to a power cycle) with the stored configuration information. The Examiner merely identifies how Pelissier's central network manager can query or update the information (Ans. 4).

The difficulty that we have with this anticipation rejection before us is that there is no certainty from the Pelissier reference itself as to when the topology information is being obtained (i.e., whether responsive to a power cycle or not). Pelissier merely discloses techniques for discovering the topology, not a responsive time-frame for doing so. While it seems logical that the topology discovery could be performed responsive to a power cycle, the Examiner has left it up to us to speculate and has not presented an alternative obviousness rejection of claim 1. Further, the Examiner has not shown where Pelissier compares current configuration information with stored information. We decline to engage in speculation in deciding this issue. The absence of "responsive to a power cycle, obtaining current configuration information . . ." and "comparing the current configuration information with the stored configuration information" negates anticipation.

Since we agree with at least the above noted arguments advanced by Appellants, we need not reach the merits of Appellants' other arguments. It follows that Appellants have shown that the Examiner erred in finding Pelissier renders claims 1-7, 15-21, and 25 unpatentable.

Therefore, we reverse the anticipation rejection of claim 1, and of claims 2-7, 15-21, and 25, which stand therewith.

*Group II*  
*Claims 8, 22, and 26*

Appellants contend:

To the contrary, the network discovery described in Pelissier merely sends out management cells which compile a list of port numbers in their arrays to thereby discover the network topology. The devices may then be configured by assigning a MAC address and a forwarding database to the device. This configuration does not include any determination as to whether the device was previously at this location or not and if so, using previously stored configuration information.

(App. Br. 16.) Appellants further contend that “Pelissier also does not teach configuring the component without previously stored configuration information if the component was not previously in the location.” (*Id.* at 17.)

The Examiner found that in Pelissier “. . . the central network manager 150 may periodically rediscover the network topology, reassign MAC addresses to devices, and generate updated forwarding databases for each device based on the new network topology.’ (‘or configuring the component [sic] without the previously stored configuration information if the component was not previously in the location.’)” (Ans. 21-22.)

Issue: Have Appellants shown that the Examiner erred in finding that Pelissier discloses *configuring the component without the previously stored configuration information if the component was not previously in the location?*

Pelissier discloses that the central network manager may periodically rediscover the network topology when devices are added, removed, or relocated (FF 5). Thus, Pelissier discloses determining whether the

component was previously in the location, as set forth in claim 8. However, claim 8 further requires *conditionally* configuring the component using previously stored configuration information. Specifically, if the component was previously in the location, configuring the component using previously stored configuration information. However, if the component was not previously in the location, claim 8 requires configuring the component without the previously stored configuration information.

While the Examiner has identified Pelissier's ability to determine whether a component has relocated in the network, the Examiner has failed to establish whether such a relocation determination controls the type of information to use to configure the component. Claim 8 specifically looks at whether the component was/was not previously in the location before deciding upon which type of configuration information to use. The Examiner has not shown and we do not readily find where Pelissier discloses such a feature. Instead, the Examiner has merely shown that Pelissier discloses updating the configuration information for each device based on the new topology. Again, the Examiner has left it up to us to speculate and has not presented an alternative obviousness rejection of claim 1. We decline to engage in speculation in deciding this issue. The absence of "configuring . . . using previously stored configuration information . . . if the component was previously in the location"; and "configuring . . . without the previously stored configuration information if the component was not previously in the location" negates anticipation.

Since we agree with at least one of the arguments advanced by Appellants, we need not reach the merits of Appellants' other arguments. It

follows that Appellants have shown that the Examiner erred in finding Pelissier renders claims 8, 22, and 26 unpatentable.

Therefore, we reverse the anticipation rejection of claim 8, and of claims 22 and 26, which stand therewith.

*Group III*  
*Claims 9, 10, 23, 24, and 27*

Appellants contend that Pelissier “says nothing regarding determining if a component has configuration information, determining if the configuration of a component has changed, or updating configuration information in a component if the configuration of the component has changed.” (App. Br. 17.)

The Examiner found that “a central manager 150 can read or query a device’s forwarding database using the Get( ) command and specifying the FDB COD, and update or initialize a device’s forwarding database using the Set( ) command and the FDB COD” (Ans. 24).

Issue: Have Appellants shown that the Examiner erred in finding that Pelissier discloses “determining whether stored configuration information is present at the component; responsive to the stored configuration information being present at the component, reading the stored configuration information?”

As noted *supra*, we find that Pelissier discloses periodically rediscovering the network topology when devices are added, removed, or relocated (FF 5). Thus, Pelissier determines whether changes to a configuration of the component are present. Pelissier further discloses that

the central network manager can read or query a device's address or can update or initialize a device's MAC address (FF 6). For example, Pelissier generates updated forwarding databases for each device based on new network topology (FF 5). Pelissier further discloses that "information is stored in a device . . . and may be queried or updated" (col. 9, ll. 21-23). Thus, we find that Pelissier's rediscovery method is consistent with the claimed determining changes in configuration and responsive thereto, updating the changes to the configuration.

Thus, Appellants have *not* persuaded us of error in the Examiner's conclusion of anticipation for representative claim 9. Therefore, we affirm the Examiner's § 102 rejection of independent claim 9 and of claims 10, 23, 24, and 27, which fall therewith.

### *The Obviousness Rejection*

#### *Group IV Claims 11-14*

We now consider the Examiner's rejection of claims 11-14 under 35 U.S.C. § 103(a) as being obvious over the combination of Shah and Pelissier.

Appellants contend that "Shah does not provide for the deficiencies in Pelissier" (App. Br. 18). Specifically, Appellants contend that "nowhere in Shah is there any teaching or suggestion regarding obtaining current configuration information . . . in response to a power cycle, comparing the current configuration information to stored configuration information for the

set of components, or updating the stored configuration information if a difference is present in the comparison.” (*Id.*)

The Examiner found that “[t]he reference Pelissier is cited to teach the argued claim limitations” (Ans. 27).

Issue: Have Appellants shown that the Examiner erred in finding that Pelissier discloses the disputed claim limitations noted *supra*?

The Examiner only relies upon Shah to disclose the mechanism for communicating to various networks (Ans. 27), and cites Pelissier to disclose the other features of claim 11 (*Id.*). As noted *supra* regarding the rejection of claim 1, the Examiner has not established and we do not readily find where Pelissier discloses that topology discovery is done responsive to a power cycle. Therefore, we find that the reasons noted above for reversing claim 1 are equally applicable here.

Since we agree with at least one of the arguments advanced by Appellants, we need not reach the merits of Appellants’ other arguments. It follows that Appellants have shown that the Examiner erred in finding Pelissier renders claims 11-14 unpatentable.

Therefore, we reverse the obviousness rejection of claim 11, and of claims 12-14, which stand therewith.

## VI. CONCLUSIONS

We conclude:

1. Appellants have shown that the Examiner erred in rejecting claims 1-8, 15-22, 25, and 26 under 35 U.S.C. § 102(e).
2. Appellants have *not* shown that the Examiner erred in rejecting claims 9, 10, 23, 24, and 27 under 35 U.S.C. § 102(e).



3. Appellants have shown that the Examiner erred in rejecting claims 11-14 under 35 U.S.C. § 103(a).

## VII. DECISION

In view of the foregoing discussion,

1. We reverse the Examiner's rejection of claims 1-8, 15-22, 25, and 26 under 35 U.S.C. § 102(e);

2. We affirm the Examiner's rejection of claims 9, 10, 23, 24, and 27 under 35 U.S.C. § 102(e); and

3. We reverse the Examiner's rejection of claims 11-14 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

## AFFIRMED-IN-PART

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